

## **REMARKS/ARGUMENTS**

In the Office Action, the Examiner rejected claims 1, 6, 9, 10, 13, 14, 15 and 18 under 35 USC 102(b) as allegedly being anticipated by US Patent No. 6,738,827 to Abir ("Abir"), rejected claims 1, 9 and 13 under 35 USC 103(a) as being allegedly obvious in view of US Patent No. 5,974,453 to Anderson et al. ("Anderson") and US Patent No. 5,900,871 to Atkin et al (Atkin"), and rejected Claims 2-5, 7, 8, 11, 12 and 16-17 under 35 USC 103(a) as allegedly being obvious in view of Abir and US Patent No. 6,298,341 to Mann et al. ("Mann"). The Applicants respectfully traverse each of the above rejections.

As the Examiner can appreciate the domain names in so far as they are used as the addresses of a particular registrant, e.g., a business concern, over the Internet, it is very important that no other registrant has the same domain name, i.e., the same address. The Applicants emphasized this point in the present application. For example, on page 2, lines 18-32 of the present Application, the Applicants point out:

"There is a non-ambiguous one-to-one correspondence between each URL and its associated IP address. In order to ensure the integrity of the unique correspondence between an URL and the associated IP address, it must [be] ensured that no two different servers, having different IP address from each other, share the same URL. To that end, there is a registration system in place to ensure only one registrant is assigned a particular "domain name". Presently, the authority for the registration system is with a non-profit organization, called the Internet Corporation for Assigned Names and Numbers (ICANN). Also at the present time, only one registrar for each of the domains is [are] allowed to accept registration of domain names. For example, in the case of the ".com", ".org" and the ".net" domains, the Network Solutions, Inc. (NSI), of Herndon, Virginia, USA, is the only authorized registrar for domain names. Once, a registrant registers a domain name with an authorized registrar, e.g., registering a ".com" domain name with NSI, no other entity may register the same domain name."

And, again on page 7, lines 3-9 of the present Application, the Applicants stated:

“The ADNR **102** is the authorized registrar of domain names for a particular domain. For example, at the present time, in the case of the “.com”, “.org” and the “.net” domains, the Network Solutions, Inc. (NSI), of Herndon, Virginia, USA, is the only authorized registrar for domain names. Although, by way of an example, only one ADNR **102** is shown in Fig. 1, in practice, there are a number of ADNRs **102**, each of which may serve as the registrar for a particular domain, e.g., “.gov”, “.co.uk”, “.co.kr” and the like.”

In order for the domain name system of the Internet to properly serve its purpose, preserving the integrity of the unique one-to-one correspondence between a domain name and the associated IP address is very important. That is why, the caretakers of the Internet relies on the registration system to ensure that such one-to-one correspondence is indeed preserved. In other words, the registration system ensures that the domain name database is a single database, *albeit* may be distributed over a number of domain name servers, and some domain name servers may have duplicative portions of the database, and that a domain name is allowed to be assigned to only one registrant. This is achieved by having only **authorized registrars** that together ensure the integrity of the database.

Accordingly, the registration of alphanumeric representation of non-alphanumeric domain names is not a simple administrative measure, but is an important pre-requisite in order to ensure proper operation of WWW addressing scheme. Without the benefits of, the present invention, there was no technology available to make this registration of non-alphanumeric domain names with an **authorized registrar** possible.

Applicants have amended the claims herein to make it even more clear that the present invention requires, *inter alia*, the receipt of a registration request for, and registration of, a domain name containing non-alphanumeric characters, by **an authorized registrar**.

In contrast, none of the references of record teaches the presently claimed registration of the “converted alphanumeric domain name with an authorized alphanumeric domain name registrar, said authorized alphanumeric domain name registrar being one of one or more registrar that maintain a database of domain names

usable in the Internet so as to ensure there are no duplicative domain name assignment."

While Abir suggests a translation of a non-English language word, e.g., an Israeli word, into a corresponding English word translation, Abir makes it very clear that so translated English word is not to be registered with an authorized domain name registrar, but instead is used to search for a matching "friendly resource identifier" (i.e., a conventional domain name) is searched (See Fig. 6 and Col. 3, lines 57-61). This mapping between the translated English word and its corresponding conventional domain name is accomplished by providing a lookup database, which is maintained at an ad-hoc basis, and thus cannot ensure the integrity of addressing system where the desired non-English word would be in a unique one-to-one relationship with respect to a particular domain name (See Col. 7, lines 56-60).

Abir simply does not disclose, teach or suggest registration of the converted alphanumeric domain name with an authorized registrar, and thus cannot anticipate the currently pending claims of the present application.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Accordingly, it is respectfully requested that the Examiner withdraw the rejection.

As to the Examiner's suggestion of the combination of Anderson and Atkins, the combination, even if, *arguendo*, properly combinable, which it is not, does not teach or suggest the registration of a converted alphanumeric domain name with an authorized domain name registrar as recited by the present claims.

Anderson teaches a method of providing access to a dynamically addressed IP address (which varies as the host assigns the IP address in a pseudo random manner) using a "static identifier," which could be a domain name. See Abstract and Col. 3, lines 1-18. The portions the Examiner cites, namely, Col. 3, lines 49-62) does describe the DNS system, but which is the conventional DNS system before the present invention, which the present Application also describes. Anderson, however, contrary to the Examiner's assertion, does not teach converting non-alphanumeric domain name to an alphanumeric domain name, and registering so converted domain name. Rather,

Anderson teaches using a domain name, which was pre-registered in a conventional manner, to resolve to a dynamically assigned IP address (i.e., a varying IP address.

Atkins, on the other hand, offers no teaching with respect to domain names or DNS system. Atkins merely teaches the provision of a cultural profile, which can be dynamically modified by a user, to be used in the general computing environment of the user (See Abstract).

Accordingly, the combination of Anderson and Atkins at best teaches web surfing application being performed in a "cultural environment", i.e., the user interface and the help menu being in the appropriate language while accommodating dynamically varying IP address assignment.

There is simply no teaching or suggestion by the combination of Anderson and Atkins of receiving a domain name registration request for a registration of a non-alphanumeric domain name, converting the requested non-alphanumeric domain name to a converted alphanumeric domain name, and registering so converted alphanumeric domain name with an authorized domain name registrar as the present claims recite.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Accordingly, it is respectfully requested that the Examiner withdraw the rejection.

Finally, with respect to the combination of Abir and Mann, as explained above, Abir does not teach converting a non-alphanumeric domain name into an alphanumeric domain name, and registering so converted domain name with an authorized registrar. Abir at best teaches a conventional domain name registration process where the registration request is made for a name containing alphanumeric characters only.

Mann does not cure the above deficiency of Abir, and merely suggests, presumably in order to obtain a maximum number of registered domain names containing a "root" term, by creating candidate registerable domain names by concatenating the root term with various adjunct terms. The candidate terms are tested for their availability for registration, and the resulting list provided to the requester, e.g., via an e-mail. See Abstract and Col. 4, lines 48-54.

Thus, the combination of Abir and Mann, even if, *arguendo*, properly combinable, which it is not, teaches at best receiving a conventional domain name registration request, and providing a list of candidate domain names to the user. The combination thus fails to teach receipt of a domain name registration request for a name that contains a non-alphanumeric character, and providing a registered alphanumeric domain name that corresponds to the requested name.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

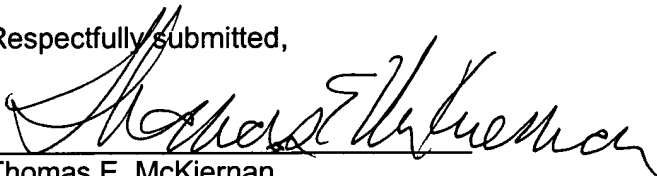
Accordingly, it is respectfully requested that the Examiner withdraw the rejection.

For at least the foregoing reasons, the Applicants request that the Examiner reconsider all outstanding rejections, withdraw the same, and allow the present application to issue.

Applicant submits that the present application is now in condition for allowance. Reconsideration and favorable action are earnestly requested.

Respectfully submitted,

By



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